

09/204,236



APPLICATION NUMBER

FILING DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

09/204,236 12/03/98 HAMILTON

G AR218-X

HM42/0321

NATH & ASSOCIATES  
1030 FIFTEENTH STREET N W  
SIXTH FLOOR  
WASHINGTON DC

CHANG, C  
DATE MAILED:

**NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)**

03/21/01

The request for continued examination (RCE) under 37 CFR 1.114 filed on \_\_\_\_\_ is improper for reason(s) indicated below:

- ☐ 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d).
- ☐ 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d).
- ☐ 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed.
- ☐ 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).
- ☐ 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on \_\_\_\_\_. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.
- ☐ 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
- ☐ 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
- ☐ 8. Others. See attachment

***A copy of this notice MUST be returned with any reply.***

Direct the reply and any questions about this notice to:

\_\_\_\_\_ Celia Chang \_\_\_\_\_, Examining Group \_\_\_\_\_ 1625 \_\_\_\_\_


(703) 30\_8\_ - 4702

Art Unit: 1625

*--attachment to PTO-2051--*

Per 37 CFR Part 1, Request for Continued Examination practice: final rules, published August 16, 2000 in the Federal Register, p.50095, ".....In addition, as 35 U.S.C. 132(b) and §1.114 provide continued examination of an application (and not examination of a continuing application), the Office will **not** permit an applicant to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined." Please note that the RCE practice does not allow switching of invention. In the instant case, please note that in Paper No. 8 restriction was required, and in Paper No. 11, an election of group I with species of compound 59, was made. The traverse was clearly answered to the reason of finding the Markush grouping to be inappropriate and the examination was delineated to be those compounds reading on the elected species i.e. R2 is CN or bioisostere thereof (see Thornber of record p.569). The method claims were examined to the same scope as the compounds limited to the specific pathology named in claim 16 (see Paper No.12, page 3). Further, the impropriety in switching was clearly delineated in the after final advisory (Paper No. 21) wherein the after final amendment if entered would have canceled all the elected invention and replaced them with an invention which is independent and distinct from those claims previously examined, thus the after final amendment was not entered and all argument in the after final response based on entry of the after final amendment was not relevant.

This recount of the status indicated that the entry of the after final amendment which constitutes switching of election is improper and the RCE must be denied.

  
CEILA CHANG  
PRIMARY EXAMINER  
GROUP 1200 625